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May 24, 2000

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150030

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Enclosed is a copy of our Deposit Account Statement of 12/30/99. Please see the highlighted charges on Serial Number 09/448,144 for \$270.00 with Fee Code #103 and \$260.00 with Fee Code #104.

We believe Claim #16 to be **Improper and not Multiple Dependent**. It refers back to the same set of Claims (6-15) twice, but for different reasons. In any event it should only be counted as 10 claims and not 20. Please investigate these charges and refund \$270.00 for extra claims and \$260.00 for the Multiple Dependent Claim fee.

Please refund a Total of \$530.00 to deposit Account #150030.

Copies of the appropriate paper work are attached.

If you have questions please do not hesitate to contact me. My phone number is 703/412-6452.

With best regards,

OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

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12	1	99	1	018528		580C	100.00	14690.71
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12	9	99	3	09034993	0107-0980-2	126	240.00	6939.71
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12	9	99	57	60113939	3844-0002-0	566	60.00	6873.71
12	9	99	164	09450950	2264-0304-0X	103	678.00	6195.71
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12	9	99	224	91210280	7791-0037-25	570	25.00	5870.71

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of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art, see MPEP § 706.03.

608.01(n) Dependent Claims

37 CFR 1.75(c) reads as follows for applications filed prior to January 24, 1978:

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

MULTIPLE DEPENDENT CLAIMS

37 CFR 1.75(c) reads as follows for applications filed on and after January 24, 1978.

37 CFR 1.75. Claim(s).

.....

(c) one or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (multiple dependent claim) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

.....

Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

The second paragraph of 35 U.S.C. 112 has been revised in view of the multiple dependent claim practice introduced by the Patent Cooperation Treaty. Thus, 35 U.S.C. 112 authorizes multiple dependent claims in applications filed on and after January 24, 1978, as long as they are in the alternative form (e.g., "A machine according to claims 3 or 4, further comprising —"). Cumulative claiming (e.g., "A machine according to claims 3 and 4, further comprising —") is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8" is improper. Section 112 allows reference to only a particular

608.01(n)

claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using Form Paragraph 7.45.

7.45 Improper Multiple Dependent Claims

Claim [1] objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim [2]. See MPEP 608.01(n). Accordingly, [3] has not been further treated on the merits.

Examiner's Note:

1. In bracket 2, insert "should refer to other claims in the alternative only" and/or, "cannot depend from any other multiple dependent claim."
2. Use this paragraph rather than 35 U.S.C. 112, fifth paragraph.
3. In bracket 3, insert "the claim has or these claims have."

Assume each claim example given below is from a different application.

ACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

Claim 5. A gadget according to claims 3 or 4, further comprising —

Claim 5. A gadget as in any one of the preceding claims, in which —

Claim 3. A gadget as in either claim 1 or claim 2, further comprising —

Claim 4. A gadget as in claim 2 or 3, further comprising —

Claim 16. A gadget as in claims 1, 7, 12, or 15, further comprising —

Claim 5. A gadget as in any of the preceding claims, in which —

Claim 8. A gadget as in one of claims 4-7, in which —

Claim 5. A gadget as in any preceding claim, in which —

Claim 10. A gadget as in any of claims 1-3 or 7-9, in which —

Claim 11. A gadget as in any one of claims 1, 2, or 7-10 inclusive, in which —

UNACCEPTABLE MULTIPLE DEPENDENT CLAIM WORDING

A. Claim does not refer back in the alternative only

Claim 5. A gadget according to claim 3 and 4, further comprising —

Claim 9. A gadget according to claims 1-3, in which —

Claim 9. A gadget as in claims 1 or 2 and 7 or 8, which —

Claim 6. A gadget as in the preceding claims in which —

Claim 6. A gadget as in claims 1, 2, 3, 4 and/or 5, in which —

Claim 10. A gadget as in claims 1-3 or 7-9, in which —

15. The method of manufacturing said separator of said proton exchange fuel cell according to claim 14, further comprising the step of:

after recovering said separator substrate, pulverizing and resolving said recovered separator substrate electrically, mechanically or chemically; and

reusing material of said recovered separator substrate in manufacturing said separator of said proton exchange fuel cell.

16. The separator of a proton exchange fuel cell according to one of claims 6 - 15, wherein:

said separator is manufactured by using said method of manufacturing said separator of said proton exchange fuel cell according to one of claims 6 - 15.